



10 JUN 2002

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In re Application of
PILU, Maurizio *et al*
Application No.: 09/786,825
PCT No.: PCT/GB00/02621
Int. Filing Date: 07 July 2000
Priority Date: 09 July 1999
Attorney's Docket No.: 30980088US
For: DOCUMENT IMAGING SYSTEM

**DECISION ON RENEWED
REQUEST TO WITHDRAW
HOLDING OF ABANDONMENT
AND 37 CFR 1.182**

This decision is in response to applicants' "Response to Decision on Request to Withdraw Holding of Abandonment and Petition Under 37 C.F.R. § 1.182" ("Ren.Pet.") filed on 22 March 2002.

BACKGROUND

On 04 March 2002, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed because it was determined that applicants did not have any authorization to charge the required fees from Deposit Account No. 08-2025.

On 22 March 2002, applicants submitted the instant response which was accompanied by, *inter alia*, a document titled "Summary of Facts" and a copy of check No. 341619 for \$860.00.

DISCUSSION

In the renewed petition, applicants request that the USPTO review:

- (1) whether the basic national fee should be deemed paid as of 09 March 2001 even though the USPTO did not charge the basic national fee to the Deposit Account number listed on the transmittal letter, and
- (2) whether the holding of abandonment for failure to pay the basic national fee should be withdrawn.

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT NO. 08-2025

It is noted that after investigating this matter with the Receipts Accounting

Division of the Office of Finance at the USPTO, neither Mr. John W. Ryan nor the law firm Wilmer, Cutler & Pickering was authorized to charge any fees to the Hewlett-Packard Company's ("HP") Deposit Account No. 08-2025 on 09 March 2001.

In the renewed petition, applicants claim that "the USPTO should have charged the HP deposit account in this application based on the undersigned counsel's actual and apparent authority." Ren.Pet. at ¶ 4.

Actual Authority

Counsel asserts that he possessed actual authority to charge the basic national fee to the aforementioned Deposit Account based on the "Affidavit of Authority to Charge Deposit Account" signed by Mr. Jeffery B. Fromm of HP submitted with the prior petition on 17 September 2001.

A review of this document verifies that it confers actual authority on Mr. Ryan to charge official fees to Deposit Account No. 08-2025. However, this document was signed on 15 August 2001 which is well after the basic national fee was required to be paid pursuant to 37 CFR 1.494(b)(2) on 09 March 2001. Therefore, Mr. Ryan's actual authority did not mature until after the above-captioned application was abandoned. Counsel's argument is not supported by the facts.

Apparent Authority

Applicants argue that listing the corporation on the transmittal letter "is not the only way to provide an indication of counsel's affiliation with an assignee in order to authorize charging the assignee's deposit account." *Id.* at ¶ 6. Applicants claim that "the undersigned counsel had apparent authority to charge the HP deposit account as manifested by the HP information provided in the national stage papers and specifically listed on the assignment and the assignment recordation cover sheet." *Id.* at ¶ 5.

Applicants also argue that "[a]n assignment is, in fact, capable of indicating counsel's affiliation with an assignee to enable the USPTO to properly charge HP's deposit account" as U.S. application 09/786,768 ('768) was "formally identical to the filing of the subject application in that they both included transmittals and declarations that did not list the HP correspondence address, but both included assignments that did list the HP correspondence address." *Id.* at ¶ 8 (emphasis omitted).

Applicants liken the listing of HP on the declaration with the listing of HP on the assignment. They are not the same. Section 301 of the Manual of Patent Examining Procedure (MPEP) states, in part:

An assignment can be made of record in the United States Patent and Trademark Office in two different ways, for two

different purposes. The differences are important to note:

(A) An assignment can be made of record in the assignment records of the Office. Recordation of the assignment provides legal notice to the public of the assignment. It should be noted that recording of the assignment is merely a ministerial act; it is not an Office determination of the validity of the assignment document nor the effect of the assignment document on the ownership of the patent property. See 37 CFR 3.54 and MPEP § 317.03; and

(B) An assignment can be made of record in the file of a patent application, patent, or other patent proceeding (e.g., reexamination proceeding). This step is necessary to permit the assignee to "take action" in the application, patent, or other patent proceeding under the conditions set forth in 37 CFR 3.73 and MPEP § 324. Recordation of an assignment in the assignment records of the Office does not, by itself, permit the assignee to take action in the application, patent, or other patent proceeding.

First, the assignment in the above-captioned application was fashioned under § 301(A) of the MPEP above to provide legal notice to the public of the assignment. Accordingly, this "ministerial act" is not sufficient to show the necessary affiliation between HP and counsel to allow the USPTO to charge official fees in HP's Deposit Account. This would have required that the assignment be made of record in the above-captioned application.

Second, a review of '768 reveals that the file contains no indication that counsel was affiliated with HP. Nevertheless, the USPTO charged the basic national fee to Deposit Account No. 08-2025 on 09 March 2001. This was improper.

In '768, counsel had no authority to charge any fees to Deposit Account No. 08-2025 on 09 March 2001. Accordingly, '768 should also have been abandoned pursuant to 37 CFR 1.494(b)(2). Nonetheless, no action will be pursued by the USPTO to abandon '768.

Charge Fees Pursuant to 37 CFR 1.34

Counsel asserts that by signing a cover sheet authorizing the charging fees to a Deposit Account "should have been enough authorization for the USPTO to withdraw the required funds" pursuant to 37 CFR 1.34. Id. at ¶ 10. Further, counsel charges that the assignment previously discussed and an Information Disclosure Statement submitted on 09 March 2001 on HP letterhead "provided full corroboration and

indication of the undersigned's affiliation with HP." Id.

This argument is unpersuasive.

The scope of 37 CFR 1.34 does not extend to the authorization of any practitioner to access a Deposit Account solely on the signature of the same practitioner. Other safeguards are involved. Deposit Account Rules and Information are posted on the official USPTO website. The rules are designed to protect and accommodate practitioners and the public.

The rules specifically state that "[i]t is also the responsibility of the account holder to keep the USPTO informed of all individuals or organizations that are authorized to make charges against the deposit account. Only requests signed by persons on the authorized user list will be processed." Therefore, the account holder must update the authorized user list to enable the authorized user to charge required fees. In this case, HP did not update the authorized user list until after 19 March 2001.

Actions Contradict USPTO Customer Service Policy

Counsel argues that the "non-acceptance of the undersigned's signed authority is contradictory to USPTO customer service policy." Id. at ¶ 11.

The USPTO's customer service policy is a balancing act between protecting the integrity of system and meeting the needs of the customers. In this case, protecting the financial integrity of the Deposit Account rules clearly outweigh applicants' dissatisfaction with the results of the prior decision.

If the USPTO allowed unauthorized persons access to an account holder's Deposit Account, then the USPTO would be obliged to reimburse these funds. The best way for the USPTO to meet the needs of our customers in this regard is to ensure the integrity of the Deposit Account system. Neither Mr. Ryan nor the law firm Wilmer, Cutler and Pickering were authorized to charge any funds to Deposit Account No. 08-2025 on 09 March 2001.

Basic Fee Timely Paid

Finally, counsel contends that "the basic fee should be deemed timely paid because in fact, the fee has already been paid - not once but twice." Id. at ¶ 12. Moreover, in the "Summary of Facts" listed in Appendix A, counsel claims that "[o]n March 12, 2002, in a telephone conference with Farah of the Deposit Account Department of the USPTO, it was learned that the basic national fee of \$860.00 was charged to the HP deposit account no. 08-2025 on August 20, 2001."

However, a review of USPTO financial records for the above-captioned

application and checking with the Deposit Account Department of the USPTO reveals no record that the \$860.00 basic national fee was charged to Deposit Account No. 08-2025 on 20 August 2001. The financial records simply show that the USPTO cashed a check for \$860.00 on 20 August 2001 that was received on 15 August 2001.

Even if a record existed that the USPTO charged the basic national fee twice in the above-captioned application, the remedy is to reimburse the money. This would not affect the fact that this application was abandoned for failing to meet the requirements of 37 CFR 1.494(b)(2).

Accordingly, this argument is without merit.

WITHDRAW HOLDING OF ABANDONMENT

Applicants failed to show that Mr. Ryan or the law firm Wilmer Cutler and Pickering was authorized to charge the basic national fee to Deposit Account No. 08-2025 on 09 March 2001, applicants' request to withdraw the holding of abandonment is refused.

DECISION

For the reasons listed above, applicants' renewed petition under 37 CFR 1.182, and to withdraw the holding of abandonment are both **DISMISSED** without prejudice.

The above-captioned remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Applicants should consider filing a petition to revive the above-captioned application pursuant to 37 CFR 1.137(a) or 1.137(b).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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